



## UNITED STATES PATENT AND TRADEMARK OFFICE

MAR 17 2005

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In re Application of	:
Reid W. von Borstel	:
Serial No.: 09/838136	: SUSPENSION OF ACTION
Filed: April 20, 2001	:
Attorney Docket No.: 1331-337	:

This is in response to the petition under 37 CFR 1.103, filed March 4, 2005, to suspend prosecution of the above identified application for six months.

**The petition fee of \$200.00 will be charged to applicants' Deposit Account No. 14-1140, as directed.**

Applicants seek suspension of the prosecution on this application for a period of six months because of a pending civil suit relating to the question of inventorship of this application.

#### BACKGROUND

This application was filed April 20, 2001, and has been examined. The examiner has determined that the claims are allowable.

#### DISCUSSION

##### 37 CFR 1.103. Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in §1.17(I). Action will not be suspended when a reply by applicant to an Office action is required.

M.P.E.P. 709 relates to suspension of action in an application. 37 CFR 1.103 permits the Office to suspend action upon petition by applicants for **good and sufficient cause** (emphasis added). Applicants state that they are involved in a civil suit the purpose of which is to determine inventorship. They further state that the matter is destined to be arbitrated, but that no firm date or arbitrator has been set or selected, only that proceedings should begin later in 2005.

The question of inventorship and/or ownership of an application (invention) is not a matter which relates to the determination of patentability of the application. While inventorship of an

application is presumed to be correct upon filing of an application, discovery of an error therein is correctable at any time during prosecution of the application or subsequent to issuance of the application as a patent. Thus determination of inventorship alone is not considered to be a good and sufficient reason for suspension of action in a patent application.

Applicant's statement in the petition that change of inventorship/ownership may raise issues of obvious double patenting also raises the possibility, if the inventorship/ownership is not changed, that an interference may result. The examiner will reconsider the allowability of the application in view of these scenarios.

#### DECISION

**The petition to suspend action is DENIED.** Applicant has not presented a good and sufficient cause warranting suspension of action by the examiner.

**The application will be forwarded to the examiner of record for further consideration.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the general Office facsimile number 571-273-8300.



Bruce Kisliuk  
Director, Technology Center 1600